UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/106,431	04/21/2008	David A. Miceli	66908.US	7773

408 7590 04/14/2017

LUEDEKA NEELY GROUP, P.C.
P O BOX 1871
KNOXVILLE, TN 37901

EXAMINER	
LOFTUS, ANN E	

ART UNIT	PAPER NUMBER
3692	

NOTIFICATION DATE	DELIVERY MODE
04/14/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@luedeka.com
LNG.PATENT@gmail.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID A. MICELI and JOSEPH A. MICELI

Appeal 2015–004139
Application 12/106,431
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and NINA L. MEDLOCK, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

David A. Miceli and Joseph A. Miceli (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 26–49, the only claims pending in the application on appeal. Oral arguments were presented March 12, 2017. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

---

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed August 18, 2014) and Reply Brief ("Reply Br.," filed February 23, 2015), and the Examiner's Answer ("Ans.," mailed December 23, 2014), and Final Action ("Final Act.," mailed December 20, 2013).

The Appellants invented a use of advertisements in conjunction with a vial, bottle, or other container and a closure, which may be described as a cap or a top. Spec., para. 5.

An understanding of the invention can be derived from a reading of exemplary claim 26, which is reproduced below (bracketed matter and some paragraphing added).

26. A prescription container system for

> holding and dispensing a pharmaceutical from a dispensing entity,
>
> the pharmaceutical being specified by a prescription for the patient,

the prescription container system comprising:

[1] a prescription container constructed to hold a prescribed pharmaceutical;

> [2] the prescription container including a bottom and at least first and second sides extending upwardly from the bottom to define a perimeter
>
> > such that the container has a closed cross section when taken through the sides in a plane parallel to the bottom;
>
> [3] the prescription container further including an opening to allow pharmaceuticals to be placed into and removed from the prescription container;

[4] a closure shaped to engage the container and form a seal with the container to close the opening of the prescription container;

[5] a first label panel positioned on the first side of the container and displaying first panel information including patient indicia identifying the patient and medical indicia identifying the pharmaceutical specified by the prescription and combinations thereof,

> [6] a second label panel disposed on the second side of the prescription container,
>
> [7] an advertisement displayed on the second label panel configured so that the advertisement is separate from and spaced apart from the first label panel so as to not interfere with the medical indicia and the patient indicia of the first label panel,
>
> [8] the advertisement providing distinct information concerning goods or services
>
> > wherein said distinct information is different from the first panel information provided on the first label and from the identity of the dispensing entity, and wherein the goods or services of the advertisement are different from any goods or services that are identified on the first panel.

The Examiner relies upon the following prior art:

Collie	US 3,942,710	Mar. 9, 1976
Grosskopf	US 5,727,819	Mar. 17, 1998
Schaupp	US 2002/0185212 A1	Dec. 12, 2002
Hanschen	US 2004/0122733 A1	June 24, 2004
Adler	US 2006/0163869 A1	July 27, 2006

Claims 26, 28, 38–40, and 42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, and Schaupp.

Claims 27, 32–37, 41, and 46–48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Collie.

Claims 29–31, 43–45, and 49 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Hanschen.

Claims 40–49 stand rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite a physical structure. The issues of obviousness turn primarily on whether advertising per se may distinguish the claims from the art of record and whether the art describes the motivation for placing advertising on pharmaceutical containers.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "advertisement."

02. The ordinary meaning of "advertisement" is a public notice.[2]

Facts Related to the Prior Art

Adler

03. Adler is directed to a pharmacy label system. Adler, para. 5.

04. Adler describes a label for a prescription pharmacy bottle with a first portion adapted for securing to a front portion of a bottle, a second portion adapted for securing to back portion of a bottle, and printed information on the label relating to a medication. The

---

[2] Merriam-Webster Dictionary https://www.merriam-webster.com/dictionary/advertisement; *see also* American Heritage Dictionary https://www.ahdictionary.com/word/search.html?q=advertisement. The dictionary definitions cited in Appendix A attached to Appellants' Appeal Brief are all in agreement with this definition.

printed information includes a first type of information, a second type of information, and a third type of information. The first type of information includes prescription–related information including, but not limited to, a drug identifier and a patient identifier. The second type of information includes at least one of a drug identifier and a patient identifier. The third type of information includes warning information. The first type of information is always positioned in the first portion of the label and the third type of information is always positioned on the second portion of the label, and the first type of information is printed at a 180 degree opposite orientation of the second type and third type of information. *Id.* at para. 5.

05. Adler describes a bottle container with a pair of generally flat, relatively large surfaces on opposite sides of the container for bearing the label, thereby making the label substantially easier to read. The label is configured for placement as a single piece or separate pieces, depending upon the type or size of the bottle container, to cover both of the opposite faces of the bottle container. Each label differentiates between types of information by segregating the different types of information onto different areas of the container and/or onto different areas of the label. In one embodiment, warning information is placed on a second portion of the label that is applied to a back portion of the bottle container, while conventional prescription information, such as patient name, drug name, and physician name is placed on a first

portion of the label that is applied to a front portion of the bottle container. *Id.* at para. 31.

06. Adler describes information on a portion of the label (e.g., a front portion or back portion) being further differentiated into primary information such as patient name, drug name and dose, and usage instructions and secondary information such as physician name/address, pharmacy name/address, etc. The primary information is presented in larger and/or bolder fonts, spaced away from secondary information, so that primary information conspicuously stands out to the consumer. In another embodiment, primary information is placed at an upper portion of the label and bottle container since it is the information most often required and used, with secondary information placed at a lower portion of label and bottle container to reflect its less frequent use. *Id.* at para. 32.

07. Adler describes its back portion 66 of label 60 having warnings extending horizontally across back portion 66 in a stacked, generally parallel arrangement. As shown in Figure 1, in one embodiment, one or more warnings include a pictogram, icon, or other symbol (e.g., a square, triangle, circle, etc.) unique to a particular warning or condition, and that is positioned immediately to the left of the text of the warning, thereby providing an easy visual message to the reader. These symbols are particularly useful for consumers having limited reading ability, because of language challenges or eyesight problems. *Id.* at para. 55.

Grosskopf

08. Grosskopf is directed to a resealable extended text label for pharmaceutical and like uses having a laminate cover and multiple panels including a base panel and selectively detachable additional panels, the label further including means for detecting tampering with an associated article. Grosskopf 1:6–11.

09. Grosskopf Figure 4 shows an advertisement (save 50 cents) displayed on a second panel configured so that the advertisement is separate from and spaced apart from the first label panel so as to not interfere with the first label panel. *Id.* at Fig. 4.

Schaupp

10. Schaupp is directed to high speed label placement machines wherein multiple labels are placed on an object. Schaupp, para. 3.

11. Schaupp describes a pharmaceutical container as an embodiment of the bottles to which it describes applying labels. *Id.* at para. 13.

12. Schaupp describes a label as an item that is applied by a high speed in–line or similar machine to a bottle, such as a pressure sensitive label. The label may be a conventional advertising label. *Id.* at para. 14.

13. Schaupp describes a label as being embodied as a promotional coupon. *Id.* at para. 15.

ANALYSIS

Claims 26, 28, 38–40, and 42 rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, and Schaupp

Appellants argue claim 26. The Examiner applied Adler for the structural limitations of claim 26. Final Act. 6. Adler describes the recited prescription container with at least two sides and a bottom that has a closed cross section, label panel with patient and drug information, and closure. Most pill bottles aside from the purely cylindrical bottles would satisfy this. Adler also describes the recited second label on a side different from that of the first label. This much is not under contention. Limitation [7] regarding an advertisement on a second label configured so as to not interfere with the content of the first label is also described by Adler, and apart from the content being an advertisement, is also not under contention.

Appellants contend that the recited placement and content of an advertisement on a prescription container distinguishes the claims over the art. App. Br. 4–23.

The Examiner finds that Adler's second label contains an advertisement, albeit not one meeting limitation [8], and that both Schaupp and Grosskopf describe attaching advertisements meeting limitation [8] to pharmaceutical containers. The Examiner further finds that in any event, the content of the label in limitations [7] and [8] is printed matter afforded no patentable weight. Final Act. 6–7.

We are not persuaded by Appellants' argument that Adler fails to describe an advertisement on its second label. App. Br. 4–12. This is fundamentally a claim construction argument as to the construction of the

limitation "advertisement." Appellants contend that nothing in the content of Adler's second label is an advertisement.

The Specification does not lexicographically define advertisement. The ordinary meaning of an advertisement is a public notice. FF 01–02. We construe the word "advertisement" as a public notice.

Adler describes a second label with a pharmacy name. The pharmacy name printed on every label by that pharmacy is a public notice of that pharmacy. Although it may be a regulatory requirement, the printing of the name also serves a promotional purpose, although advertisements are broader than notices solely for promotional purposes.

Appellants first contend that the plain meaning of term "advertisement" does not reasonably include the identification of the manufacturer or distributor on packaging of the product being bought. App. Br. 6. This contention is at odds with the plain meaning of the word "advertisement." A public identification of the manufacturer or distributor is a public notice of the identity of the manufacturer or distributor. Appellants provide three dictionary definitions, all of which include the definition of a public notice. Some of those definitions also suggest the context may be for promotional purposes, but those are exemplary embodiments.

Appellants contend that the Specification makes clear that "advertisement" as used in the present application does not include identification of the dispensing pharmacy. App. Br. 7. Appellants begin this contention by admitting the absence of any lexicographic definition. *Id.* Appellants essentially contend they use the word "advertisement" in a manner narrower than the ordinary meaning. Although under the broadest reasonable interpretation, the construction cannot be divorced from the

record (*In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed Cir 2011)), the use of a word in the Specification in a manner consistent with, but narrower than, its plain meaning does not require a construction narrower than the plain meaning in the claim. Limitation [8] goes on to require a narrower content, but the Examiner is only applying Adler for limitation [7] showing it was known to place some form of an advertisement, albeit outside the scope of limitation [8], on a label separate from a first label on a prescription container. The Examiner applies Grosskopf and Schaupp for limitation [8].

Appellants contend that extrinsic evidence confirms that "advertisement" as used in the present application and by people of ordinary skill in the art does not include identification of the dispensing pharmacy. App. Br. 8. Appellants cite an industry white paper, "Report of the Task Force on Uniform Prescription Labeling Requirements," as evidence. This report does not contain the word "advertising." The report recommends not using the main label for promotional purposes. Again, the plain meaning of "advertisement" is broader than a promotional tool.

Appellants contend that a broadest reasonable interpretation of "advertisement" would essentially eliminate any meaning prescribed to the term "advertisement." App. Br. 11. Our construction under broadest reasonable interpretation is the plain meaning from the dictionaries Appellants cite. Though perhaps broad, the meaning exists, is specific, and is constrained.

We are not persuaded by Appellants' argument that the limitations regarding the content of the label being an advertisement as in limitation [7] and meeting the constraints of limitation [8] must be given patentable weight. A printed advertisement is the epitome of printed matter. The test

for whether a structural limitation, such as the content of printed matter, is to be given patentable weight is whether the printed matter depends on the remaining structure, or the remaining structure depends on the printed matter. *In re Ngai,* 367 F.3d 1336, 1339 (Fed Cir 2004). The analogous test for a method claim is whether the printed matter functionally depends on the remaining steps, or the remaining steps functionally depend on the printed matter. *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed Cir 2010).

Appellants contend that the advertisement converts the container into an advertising tool having an advertising function. App. Br. 14. This much may be said of including any printed matter on anything. The inclusion converts the attendant structure into a tool to be used for reading the printed matter. This was precisely the argument that was not persuasive in both *Ngai* and *King Pharmaceutical*. Any such change is in the mind of the beholder rather than being a physically functional change. Printed matter afforded no patentable weight is that which is "useful and intelligible only to the human mind." *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969). The advertising function Appellants refer to is a psychological function discernable only in the human mind.

Appellants contend that the printed matter provides structural limitations as to positioning so as not to obscure the first label and limitation [8] narrows the scope of the recited advertisement. App. Br. 15. As to the first part of this contention, it is not the content per se that has a structural limitation, but where the content is placed. The Examiner finds that Adler's second label, even though identical to the first, nevertheless meets the structural limitation as to the separation of the two recited labels.

Adler's facts support this. As to the second part of this contention, again the Examiner applies Schaupp and Grosskopf to show it was known to attach advertising meeting limitation [8], and limitation [8] does nothing to make the advertising content physically functional.

We are not persuaded by Appellants' argument that providing an advertisement on a prescription container is new and unobvious. App. Br. 15–19. As the Examiner finds, both Grosskopf and Schaupp describe advertisements on pharmaceutical containers.

Appellants contend that Schaupp is not remotely applicable to the present invention. *Id.* at 16. Schaupp explicitly includes pharmaceutical containers among its described embodiments and corroborates Adler's description of applying plural labels. One of ordinary skill does not have to infer a connection; the connection is explicitly anticipated.

Appellants contend that prescription containers are uniquely different than typical containers such that it is not proper to combine the advertisement disclosed in Grosskopf (or Schaupp) with the prescription container of Adler. *Id.* at 16–18. Appellants first contend that prescription containers are patient centered because of regulations over the main label format. *Id.* at 16. Such regulations do not cover additional labels, and the descriptions of advertising on pharmaceutical containers in both Grosskopf and Schaupp at least evince motivation to extend their reasoning to all pharmaceutical containers. Beyond that, the ubiquity of advertising presents to any argument that one would not think to use advertising a very high hurdle.

Appellants contend that prescription containers travel in different channels of trade than pharmaceutical containers. *Id.* at 17–18. Even if true,

they are ultimately dispensed from the same pharmacies that the pharmaceutical containers of Grosskopf and Schaupp are distributed from, presenting similar advertising motivations.

Appellants contend that the significance of the differences in channels of trade between pharmaceutical and prescription containers is evidenced by the type of "advertisement" disclosed in Grosskopf. App. Br. 19. Although Grosskopf describes an advertisement attached to a pull-out to a label instead of being directly on a single completely attached label, this still shows the motivation to attach advertising to a pharmaceutical container.

We are not persuaded by Appellants' argument that the fact that no one has ever put an "advertisement" on a prescription container is convincing evidence that the claimed invention is not obvious. *Id.* at 20–23. This is a classic example of trying to prove evidence of absence from the absence of evidence. The premiere example of showing the fallacy of this argument is in the history of email. In the infancy of email, no one used it for advertising. This was not because no one thought of it. The first party who had the temerity to use it discovered why no one used it — it was considered unseemly.[3] A horrendous counter attack ensued.

It is equally likely that no one has attached advertising to a prescription pill bottle that a patient has little choice but to use because it would be unseemly to take advantage of the patient's misfortune. Over-the-counter medications which routinely include advertising are more optional to the patient, and are presumably fair game.

---

[3] Reaction to the DEC Spam of 1978, http://www.templetons.com/brad/spamreact.html

Claims 27, 32–37, 41, and 46–48 rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Collie

As to these claims reciting a triangular bottle, the Examiner applies Collie Figure 2. Final Act. 8. Appellants contend that three sides offer advantages over a cylindrical container in having plural sides to mount plural labels and suggesting the patient turn the bottle to view the additional label. App. Br. 23–24. As these same advantages pertain to Adler's four-sided bottle, and Collie demonstrates that three-sided bottles were known for their distinctive aesthetic and functional design, one of ordinary skill would have immediately envisaged using either three- or four-sided bottles.

We have reviewed the declarations by Mr. David Miceli (App. Br., Evid. App'x (Exs. B, C) and find them unpersuasive.

> The Board has broad discretion as to the weight to give to declarations offered in the course of prosecution. *See Velander v. Garner,* 348 F.3d 1359, 1371 (Fed. Cir. 2003) ("[A]ccord[ing] little weight to broad conclusory statements [in expert testimony before the Board] that it determined were unsupported by corroborating references [was] within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate."); cf. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) ("Opinion testimony rendered by experts must be given consideration, and while not controlling, generally is entitled to some weight. Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination." (citations omitted)). Although there is "no reason why opinion evidence relating to a fact issue should not be considered by an examiner," *In re Alton*, 76 F.3d 1168, 1175 n.10 (Fed. Cir. 1996), the Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations, *see Velander*, 348 F.3d at 1371; *Ashland Oil*, 776 F.2d at 294.

In re American Academy of Science, 367 F.3d 1359, 1368 (Fed. Cir. 2004). We find that Mr. Miceli's declarations describe legal rather than physical or functional attributes of the claimed structures and methods. The thrust of the declarations is that the legal requirements by most states and the federal government made the claims unobvious. There are several reasons not to place much weight on such arguments. The first is that the declarations provide no facts regarding the state of comparable law outside of the United States. Countries without such laws would pose no legal obstacles to overcome, and so the facts in the declaration are irrelevant in such countries. The second reason is that legal requirements are not technical hurdles to overcome. Legal requirements are ephemeral and subject to change or repeal and do not present technical reasons in the useful arts that something should not be done, and more importantly, do not show evidence of what one of ordinary skill would not have thought of as to structural and functional possibilities. Finally, legal requirements only affect some attributes of containers and labels and not others, so there remains reason to look to references such as those applied in the rejections.

Claims 29–31, 43–45, and 49 rejected under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Hanschen

These claims are not separately argued.

Claims 40–49 rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter

We are persuaded by Appellants' argument that the "claimed methods involve applying the advertisement to a very specific apparatus during the prescription dispensing process." Reply Br. 6.

CONCLUSIONS OF LAW

The rejection of claims 26, 28, 38–40, and 42 under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, and Schaupp is proper.

The rejection of claims 27, 32–37, 41, and 46–48 under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Collie is proper.

The rejection of claims 29–31, 43–45, and 49 under 35 U.S.C. § 103(a) as unpatentable over Adler, Grosskopf, Schaupp, and Hanschen is proper.

The rejection of claims 40–49 under 35 U.S.C. § 101 as directed to non–statutory subject matter is improper.

DECISION

The rejection of claims 26–49 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED